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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 1915.14US03

KASNER et al.

Confirmation No.: 8685

Application No.: 09/862,905

Examiner: Michael S. favi

Filed: 22 May 2001

Group Art Unit: 8673

For: RIDGE CAP TYPE ROOF VENTILATOR

BRIEF FOR APPELLANTS

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal from a Final Office Action, dated 5 November 2004, in which claims 16-17, 21-49, 51-52, 54, 56, and 58-70 were rejected. A Notice of Appeal was filed 3 February 2005.

REAL PARTY IN INTEREST

Liberty Diversified Industries, Inc., a corporation organized under the laws of Minnesota, and having offices at 5600 North Highway 169, Minneapolis, Minnesota 55428-3096, is the assignee of the patent application. Assignments by the inventors to the assignee are recorded at Reel 7259, Frame 0568 et seq., and at Reel 5231, Frame 0903 et seq.

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RELATED APPEALS AND INTERFERENCES

Applicants are unaware of any related appeals or interferences.

STATUS OF THE CLAIMS

Claims 16-17, 21-34, 49, 51-52, 54, 56, and 58-60 are rejected and are under appeal, claims 1-16, 18-20, 50, 53, 55, 57 are canceled, and claims 35-48 and 61-70 are withdrawn from consideration pursuant to a restriction requirement. The pending claims are listed in Appendix A.

The rejection of claims 16-17, 21-34, 49, 51-52, 54, 56, and 58-60 is being appealed.

STATUS OF AMENDMENTS

In a 2 May 2005 telephone conversation, Examiner Safavi confirmed that a 4 April 2005 amendment had been entered. Therefore, all amendments have been entered.

SUMMARY OF CLAIMED SUBJECT MATTERClaim 16

In the embodiments of the invention claimed, claim 16 recites, *inter alia*, a roof ventilator 10 comprising a top panel 64 and at least one ventilator section 12 (e.g., column 4, lines 28-31; column 5, lines 7-13; roof ventilator 10 and ventilator section 12 in Figure 2, and top panel 64 in Figure 3). The at least one ventilator section, in turn, comprises a ventilator first panel 48, 50 and an interconnected ventilator second panel 52, 54 (e.g., column 5, lines 14-19; first panels 48 and 50 and second panels 52 and 54 in Figures 3 and 4). The at least one ventilator section 12 is in parallel abutting contact with the top panel 64 (e.g., ventilator sections 12 in parallel abutting contact with the unnumbered top panel in Figure 2). The top panel and ventilator first and

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second panels may be made from a material, which has first and second planar (liner) plies 30, 32 and an intermediate ply 34 disposed between the planar plies to define a multiplicity of air passages (spaces) 36 (e.g., column 2, lines 41-48; planar plies 30, 32, intermediate ply 34, and air passages 36 in Figure 10). Claim 16 recites that the top panel defines a recessed area 36 in which the first planar ply 32 and at least a portion of the intermediate ply 34 are removed so that the recessed area is generally non-linear in cross section and exposes at least a portion of the air passages in the top panel and so that the interior region 76 of the ventilator is in fluid communication with the exterior of the ventilator (e.g., column 6, lines 42-55; recessed area 86, planar ply 32, intermediate ply 34, and recessed area 86 in Figures 7, 11, and 12).

Claim 49

In the embodiment claimed, claim 49 recites, inter alia, a ventilator 10 comprising: first and second ventilator sections 12 (e.g., column 4, lines 28-35; ventilator Figure 2), which extend generally symmetrically outboard from a substantially longitudinal center line (generally parallel with element C in Figure 3). The first and second ventilator sections 12 may include first and second panels 48, 50 (e.g., column 5, lines 3-13; first and second panels 48, 50 in Figures 3 and 4) made from a corrugated material 28 defining a plurality of air passages 36 (e.g., column 4, lines 37-48, material 28 in Figure 4; air passages 36 in Figures 10 and 13) and a plurality of apertures (pockets) 74 (e.g., column 6, lines 8-14, apertures 74 in Figures 1-6 and 15). The first and second panels 12 may be in a contacting stacked relationship (e.g., Figure 2). The air passages 36 may conduct air from inside the roof peak to outside the roof peak. (e.g., column 2, lines 48-53) The apertures 74 may extend generally transversely to, and substantially interrupt at least a portion of, the air passages 36 (e.g., column 6, lines 7-14; apertures 74 in Figure 2).

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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Are claims 16-17, 21-49, 51-52, 54, 56, and 58-70 properly rejected under 35 U.S.C. § 251 as an improper recapture of broadened claimed subject matter?

ARGUMENTRECAPTURE RULEA. LEGAL BACKGROUND

1. The Recapture Rule does not require each and every limitation added during prosecution of the original patent application to be included in reissue claims.

If a reissue application is filed within two years of the issue date of a patent to be corrected, or properly claims priority to a reissue application filed within two years of the issue date of a patent to be corrected,¹ the statute allows for the claim to be broadened during prosecution.² While subject matter properly classified under the Recapture Doctrine sometimes must be present in a reissue claim, not all limitations added to all claims during prosecution of the original patent need be present in the reissue claim.³

¹ M.P.E.P. § 1451 ("The court in *In re Graff*, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997) stated that "[t]he statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met." Following the decision in *Graff*, the Office has adopted a policy of treating continuations and divisionals of reissue applications, to the extent possible, in the same manner as continuations and divisionals of non-reissue applications.").

² 35 U.S.C. § 251, ¶ 4 ("No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.").

³ *Ex parte Eggert*, 67 USPQ2d 1716, 1723 (Bd. Pat. App. & Inter. 2003) (The examiner contends that the Recapture Rule prohibits a patentee from obtaining in reissue any claim which does not include each and every limitation added to a claim or argued by an applicant during the prosecution of the original patent application in order to overcome a rejection and obtain a patent.... This approach, while certainly relatively simple in its application, has been expressly rejected by the Court of Customs and Patent Appeals (CCPA) and the Court of Appeals for the Federal Circuit (Federal Circuit).").

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The proper focus is on the scope of the claims in the original patent, not individual limitations.⁴

2. The Recapture Rule may be properly invoked only if the subject matter at issue has been surrendered by Applicants.

Surrendered subject matter must have been conceded by Applicants as unpatentable. To have been conceded as unpatentable, subject matter in a claim must have been rejected and Applicants must have conceded that the subject matter was unpatentable by further amending the claim. However, subject matter added to a claim in the final amendment before allowance may not be properly classified within the ambit of recapture subject matter. The scenario described in Ex parte Eggert⁵ provides an excellent explanation of when subject matter is conceded by Applicants as unpatentable. In Eggert, the U.S. Patent and Trademark Office Board of Appeals and Interferences was asked to impose a per se rule to prevent appellants from "retreating" from "any claim limitation determined to have secured allowance of the original patent."⁶ The Board declined to do so.⁷ Once amended claim 1 was rejected as obvious. The appellants then amended claim 1 a second time. Twice amended claim 1 was allowed by the examiner.⁸ By amending claim 1 a second time, the appellants conceded that claim 1, once amended, was

⁴ Ex parte Eggert, 67 USPQ2d 1716, 1724 (Bd. Pat. App. & Inter. 2003) ("Ball also establishes that '[t]he proper focus is on the scope of the claims, not on the individual feature or element purportedly given up during prosecution of the original application.'").

⁵ Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003).

⁶ Ex parte Eggert, 67 USPQ2d 1716, 1717 (Bd. Pat. App. & Inter. 2003) ("In the request for rehearing, it appears that the examiner has asked this Board to impose a per se rule of reissue recapture to prevent appellants from retreating from any claim limitation determined to have secured allowance of the original patent. For the reasons set forth below, we decline to do so.).

⁷ Id.

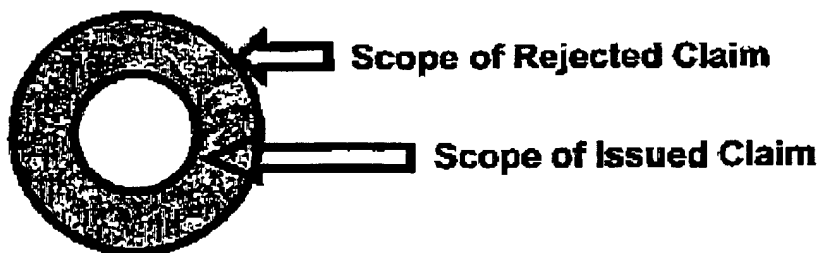
⁸ Ex parte Eggert, 67 USPQ2d 1716, 1717 (Bd. Pat. App. & Inter. 2003) ("There came a time in the prosecution of the '992 application that claim 1 (once amended) ... was met by a final rejection from the examiner.... At that time, appellants ... amended claim 1 a second time. Upon consideration of claim 1 (twice amended), the examiner determined that it was patentable. Thus, claim 1 (twice amended) became issued claim 1.").

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unpatentable.⁹ However, the subject matter intermediate between once amended claim 1 and twice amended claim 1 was not conceded as unpatentable because the examiner was never directly presented with a claim intermediate in scope between once amended claim 1 and twice amended claim 1.¹⁰ Hence, conceded subject matter is determined by the scope of a given claim before being amended into allowable form.¹¹ Stated otherwise, the subject matter in the canceled claim before being allowed is subject matter subject to the Recapture Rule. In summary, the subject matter recited in a claim before being amended into allowable form is conceded as

⁹ Ex parte Eggert, 67 USPQ2d 1716, 1717 (Bd. Pat. App. & Inter. 2003) ("Another [option] was to concede that rejected claim 1 (once amended) was unpatentable and to amend that claim in an attempt to define narrower, patentable subject matter.").

¹⁰ Ex parte Eggert, 67 USPQ2d 1716, 1717 (Bd. Pat. App. & Inter. 2003) ("The changing scope of a claim during the administrative examination process as it is amended to overcome prior art rejections can be viewed as a series of concentric circles. As illustrated in Drawing 1, the scope of rejected claim 1 (once amended) is the outer circle and the scope of amended issued claim 1 (twice amended) is the inner circle. The shaded area between the circles represents subject matter which is only narrower than the scope of the rejected claim but only broader than the scope of the issued claim. In our view, the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter appellants conceded was unpatentable. The subject matter of the shaded area was not subject to the administrative examination process as the examiner was never directly presented with a claim which fell within the scope of the shaded area. Thus, appellants have never conceded that a claim falling within the scope of the shaded area of Drawing 1 is unpatentable and therefore, in our view, such subject matter is not barred by the Recapture Rule.").



Drawing 1

¹¹ Ex parte Eggert, 67 USPQ2d 1716, 1724 (Bd. Pat. App. & Inter. 2003) ("In Mentor [citation omitted] the Federal Circuit reiterated its statement from Ball that "[t]he Recapture Rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application....") (emphasis added).

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unpatentable and is surrendered under the Recapture Rule. However, subject matter added to the claim after the final cancellation is not barred by the Recapture Rule.

3. The Recapture Rule may be avoided in some circumstances.

Notwithstanding the Recapture Rule, Applicants are entitled to obtain through reissue the scope of protection they are entitled to, e.g., overlooked aspects thereof. To this end and even if arguably including subject matter subject to the Recapture Rule, a reissue claim should nevertheless be allowed if it contains a limitation materially narrower in other overlooked aspects of the invention.¹² The narrowed limitation should be unrelated to the rejections in the original claim (or amendments in response to the rejections) if the Recapture Rule is to be avoided in this way.¹³

B. THE CLAIM REJECTIONS

Claims 16-17, 21-34, 49, 51-52, 54, 56, and 58-60 "are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based."¹⁴

1. Claim 16 is not properly rejected under the Recapture Rule

¹² See Hester Industries, Inc. v. Stein, Inc., 46 U.S.P.Q.2d 1641, 1649-1650 (Fed. Cir. 1998) ("Finally, because the Recapture Rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See, e.g., Mentor, 27 USPQ2d at 1525 (Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the Recapture Rule.); Clement, 45 USPQ2d at 1165. For example, in Ball the Recapture Rule was avoided because the reissue claims were sufficiently narrowed (described by the court as 'fundamental narrowness') despite the broadened aspects of the claims. 221 USPQ at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the Recapture Rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the Recapture Rule is to allow the patentee to obtain through reissue the scope of protection to which he is rightfully entitled for such overlooked aspects.").

¹³ Id.

¹⁴ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, pages 2-3.

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a) a first aperture

Claim 16 is rejected under the Recapture Rule for canceling limitations to "a first aperture extending through a first one of the plurality of vent panels and interrupting at least a portion of the multiplicity of air passages."¹⁵

Applicants first note that U.S. Patent 5,094,041 has claims reading on two separate claimed embodiments. Claims to the first embodiment read on roof ventilators having apertures or pockets in the vent panels or vent parts.¹⁶ Claims to the second embodiment read on roof ventilators with a recessed area in the top panel.¹⁷ Independent claims 1, 4, 7, and 8 of U.S. Patent 5,094,041 read on the first embodiment and independent claim 9 reads on the second embodiment. None of claims 1, 4, 7, and 8 recite the recessed area in the top panel. Moreover, claim 9 does not recite apertures or pockets in the vent panels or vent parts. Reissue claim 16 recites the recessed area in the top panel, which claim 9 of the original patent recites. Reissue claim 49 is drawn to the second embodiment of the invention and recites equivalent language to the foregoing limitation.¹⁸ Therefore, the proper reference claim for reissue claim 16 in this context is claim 9 of the original patent, not claim 1.

Additionally as shown above, there is no per se requirement for reissue claims to recite each and every limitation added to every claim of the original patent during prosecution. Other

¹⁵ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, page 3 ("Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to --a first aperture extending through a first one of the plurality of vent panels 'and interrupting at least a portion of the multiplicity of air passages therein' -- as has been inserted by amendment within claim 1 during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

¹⁶ See Appendix A, claims 1-8.

¹⁷ See Appendix A, claims 9-15.

¹⁸ See Appendix A, claim 49.

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than asserting the requirement in the context of the Recapture Doctrine apparently as a per se rule, the 5 November 2004 Office Action has not addressed the scope of reissue claim 16, which is required, inter alia, by Eggert.

Because reissue claim 16 is drawn to a different claimed embodiment of the invention and because the 5 November 2004 Office Action has not addressed the scope of reissue claim 16 with respect to the original claims, the rejection of claim 16 for not including the foregoing limitation is improper and Applicants respectfully request reversal.

b) a second aperture

Claim 16 is rejected under the Recapture Rule for canceling limitations to "a second aperture extending through a second one of the plurality of vent panels and interrupting at least a portion of the multiplicity of air passages therein."¹⁹

As noted above, U.S. Patent 5,094,041 has claims reading on two separate claimed embodiments, roof ventilators with apertures or pockets in the vent panels or vent parts and roof ventilators with a recessed area in the top panel. Independent claims 1, 4, 7, and 8 of U.S. Patent 5,094,041 read on the former embodiment and independent claim 9 reads on the latter embodiment. None of claims 1, 4, 7, and 8 recite the recessed area of the top panel and claim 9 does not recite apertures or pockets in the vent panels or vent parts. Reissue claim 49 is drawn to the second embodiment and includes equivalent language to the limitation at issue.

¹⁹ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, pages 3-4 ("Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to -- a second aperture extending through a second one of the plurality of vent panels and interrupting at least a portion of the multiplicity of air passages therein -- as had been inserted by amendment within claim 1 during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

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As stated above, there is no per se requirement for reissue claims to recite each and every limitation added to every claim during prosecution of the original patent. Moreover, other than asserting recapture or a per se rule, the 5 November 2004 Office Action does not address the scope of reissue claim 16 as required by Eggert.

Because reissue claim 16 is drawn to a different embodiment of the invention than described by the limitation at issue and because the scope of reissue claim 16 with respect to original claim 1 was not addressed in the 5 November 2004 Office Action, Applicants respectfully submit that the rejection of claim 16 for not including the limitation at issue was improper and respectfully request reversal.

c) at least one first aperture

Claim 16 is rejected under the Recapture Rule for canceling limitations to "at least one first aperture extending through the first vent panel and interrupting at least a portion of the multiplicity of air passages."²⁰

As noted above with respect to the rejection addressing "a first aperture," reissue claim 16 reads on the second claimed embodiment of the invention and reissue claim 49, which recites an equivalent limitation to the limitation at issue, reads on the second embodiment. Therefore, reissue claim 16 should not be required to recite limitations reading on both embodiments of the invention.

²⁰ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, page 4 ("Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to -- at least one first aperture extending through the first vent panel and interrupting at least a portion of the multiplicity of air passages' -- as had been inserted by amendment within claim 4 during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

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As also noted above, not every limitation to every original claim must be present in reissue claims. In this case, the 5 November 2004 Office Action, rather than addressing the scope of reissue claim 16 with respect to original claim 4, improperly attempted to apply a per se rule.

Because reissue claim 16 reads on an embodiment of the invention which does not recite the limitation at issue and because the comparative scope of claim 16 was not addressed, Applicants respectfully submit that the rejection of claim 16 in the 5 November 2005 Office Action for not reciting the limitation at issue was improper. Accordingly, Applicants respectfully request reversal.

d) at least one second aperture

Claim 16 is rejected under the Recapture Rule for canceling limitations to "at least one second aperture extending through the first vent panel and interrupting at least a portion of the multiplicity of air passages."^{21,22}

As noted above, the first claimed embodiment of the invention is roof ventilators with apertures and the second embodiment is roof ventilators with a recessed area in the top panel. As also noted above when addressing the rejection concerning "a second aperture," the limitation at issue reads on the second embodiment of this invention. To this end, reissue claim 49 reads on

²¹ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, page 4 ("Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to -- at least one second aperture extending through the first vent panel and interrupting at least a portion of the multiplicity of air passages' -- as had been inserted by amendment within claim 4 during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

²² U.S. Patent Application 09/862,905, 5 November 2004 Office Action, page 4 ("The deleted limitations alluded to above with respect to claims 1, 4, and 7 have also been argued as a basis for patentability of claims 1, 4, and 7 on pages 8, (lines 17-20), 9, (lines 18-21), 11, (lines 11-14), and 12, (lines 19-24), of the October 10, 1990 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

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the embodiment of the invention covered by original claims 1, 4, 7, and 8 and reissue claim 16 reads on the embodiment covered by original claim 9. Original claim 9 was not amended to recite apertures during the prosecution of U.S. Patent 5,094,041. Hence, the reference for determining recapture should be original claim 9, not original claims 1, 4, 7, and 8.

As also shown above, not every limitation added to every claim is required to be present in reissue claims. The rejection of reissue claim 16 for not including the limitation at issue should have addressed its scope relative to the scope of claim 4 and not have attempted to apply a per se rule.

Because reissue claim 16 reads on a different embodiment of the invention than is described by the limitation at issue and because of an improperly applied per se rule regarding recapture rather than addressing the scope of claim 4, Applicants respectfully request reversal of the rejection.

e) a pocket

Claim 16 is rejected under the Recapture Rule for canceling limitations to "a pocket defined by and extending at least partially through at least a one of the vent parts with 'said pocket being spaced apart from the interior region by the vent part.'"²³

Original claim 8 reads on the first claimed embodiment of the invention, which is properly described by the limitation at issue. However, claim 16 reads on the second claimed

²³ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, pages 4-5 ("Claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60, (particularly claims 16 and 49), cancel limitations to --a pocket defined by and extending at least partially through at least a one of the vent parts with 'said pocket being spaced apart from the interior region by the vent part' -- as had been inserted by amendment within claim 8 (amendment A and amendment D), during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

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embodiment, which does not recite this limitation. Hence, Applicants respectfully submit that the rejection requiring inclusion of this limitation is improper.

Again the rejection on the 5 November 2004 Office Action improperly applied a per se rule rather than address the comparative scope of reissue claim 16 with respect to the scope of the issued claims.

Claim 16 was improperly rejected for not reciting the foregoing limitation, which is not properly included in the embodiment being claimed. Claim 16 was also improperly rejected by applying a per se rule. To this end, Applicants respectfully request that the rejection be reversed.

f) said pocket ... partially enclosed

Claim 16 is rejected under the Recapture Rule for canceling limitations to

said pocket being at least partially enclosed along a first side disposed closest to the interior region of the roof ventilator by said one of the vent parts as well as said pocket being at least partially enclosed along a second side disposed closest to the exterior region surrounding the roof ventilator by said one of the vent parts.²⁴

Original claim 8 reads on the first claimed embodiment of the invention which is properly described by the limitation at issue. By contrast, reissue claim 16 reads on the second claimed embodiment, which does not have the limitation at issue. Therefore, Applicants submit that the rejection requiring reissue claim 16 to recite the foregoing limitation is issue is not proper.

²⁴ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, page 5 ("Further claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60, (particularly claims 16 and 49), cancel limitations to 'said pocket being at least partially enclosed along a first side disposed closest to the interior region of the roof ventilator by said one of the vent parts' as well as 'said pocket being at least partially enclosed along a second side disposed closest to the exterior region surrounding the roof ventilator by said one of the vent parts' as had been argued as a basis for patentability of claim 8 on pages 2-3 of the July 1, 1991 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

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Here again the rejection in the 5 November 2005 amendment improperly attempted to apply a per se rule rather than address the scope of reissue claim 16 to the scope of the original claims.

Because reissue claim 16 was improperly rejected for not including a limitation reading on another embodiment of the invention and because a per se rule was incorrectly applied, Applicants respectfully request reversal of this rejection.

g) a recessed area

Claim 16 is rejected under the Recapture Rule for canceling limitations to

a recessed area cut in the top panel with the recessed area defining a plurality of openings with "each of said plurality of openings having a pair of side walls defined by the intermediate ply, each of said pair of side walls traversing a generally oval shaped path, such that the top panel may be manually folded across a path disposed within said recessed area."²⁵

In a 28 February 1991 amendment, original claim 9 was amended into allowable form to recite:²⁶

9. [As amended by paper #13, 28 February 1991] In a roof ventilator for mounting on a peak of a roof having a roof opening, said roof ventilator having a pair of vent parts disposed on opposing sides of said roof opening and a top panel disposed above said pair of vent parts, said top panel being constructed of a double-faced corrugated sheet material having a pair of planar plies spaced apart a distance and an intermediate ply, said intermediate ply having a multiplicity of convolutions and being disposed between and connected to each of said pair of planar plies to define a longitudinal grain and a multiplicity of partially enclosed air passages extending therethrough parallel with said longitudinal grain, said roof

²⁵ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, page 5 ("Claims 16, 17, 31-34, (particularly claim 16), cancel limitations to -- a recessed area cut in the top panel with the recessed area defining a plurality of openings with 'each of said plurality of openings having a pair of side walls defined by the intermediate ply, each of said pair of side walls traversing a generally oval shaped path, such that the top panel may be manually folded across a path disposed within said recessed area' -- as had been inserted by amendment within claim 9, as well as argued on pages 4-5 of the March 4, 1991 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

²⁶ Inserted subject matter is underlined.

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ventilator defining an interior region and an exterior region surrounding said roof ventilator, said top panel having an underside defined by a one of the pair of planar plies communicating with and proximate to said interior region, the improvement comprising:

a recessed area cut in and extending at least partially into the underside of the top panel, said recessed area extending through the one of the pair of planar plies defining the underside of the top panel and at least partially through the intermediate ply, said recessed area defining a plurality of openings, each of said openings communicating with a one of the multiplicity of air passages such that air may pass from the interior region of the roof ventilator through said plurality of openings defined by said recessed area into the multiplicity of air passages and to the exterior surrounding the roof ventilator, each of said plurality of openings having a pair of side walls defined by the intermediate ply, each of said pair of side walls traversing a generally oval-shaped path, such that the top panel may be manually folded across a path disposed within said recessed area.²⁷

As shown above, the inserted limitation was added to claim 9, which was then allowed without further amendment. Thus, the reference for determining subject matter arguably subject to the Recapture Rule is the canceled form of claim 9 without the limitation at issue - not claim 9 with the added limitation. Stated otherwise, the limitation at issue was not present in any canceled claim and is not, therefore, subject to the Recapture Rule. Also as seen above, a claim with subject matter intermediate in scope between claim 9 without the limitation and claim 9 with the limitation has never been presented for a determination of patentability. Indeed other than improperly rejecting claim 9 for excluding the added limitation, the rejection in the 5 November 2004 Office Action has not otherwise rejected claim 9 as unpatentable.

Because the limitation at issue was not present in any canceled claim during the prosecution of U.S. Patent 5,094,041, it is not subject to the Recapture Rule. Hence, Applicants respectfully request that the rejection be reversed.

2. Claim 49 is not properly rejected under the Recapture Rule

a) a pocket

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Claim 49 is rejected under the Recapture Rule for canceling limitations to "a pocket defined by and extending at least partially through at least a one of the vent parts with said pocket being spaced apart from the interior region by the vent part."²⁸

As shown above, a reissue claim otherwise subject to the Recapture Rule should be allowed if it contains a narrower limitation than recited in the original claim and which was not the subject of a rejection during prosecution of the original patent. In the case at issue, two limitations not recited in original claim 8 are present in reissue claim 49.^{29,30} Neither of these limitations was added or the subject of amendments during the prosecution of U.S. Patent 5,094,041. Moreover, both of these limitations are materially narrower in aspects unrelated to the rejection of original claim 8 during prosecution. Therefore, the Recapture Rule does not preclude the allowability of reissue claim 49, because claim 49 contains limitations materially narrower in aspects unrelated to the rejection of original claim 8. Because the Recapture Rule does not preclude the allowability of reissue claim 49, Applicants respectfully request reversal of this rejection.

b) said pocket...at least partially enclosed

Claim 49 is rejected under the Recapture Rule for canceling limitations to

²⁷ U.S. Patent Application 07/479,376, Paper No. 13, 28 February 1991 Office Action, pages 1-2.

²⁸ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, pages 4-5 ("Claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60, (particularly claims 16 and 49), cancel limitations to --a pocket defined by and extending at least partially through at least a one of the vent parts with 'said pocket being spaced apart from the interior region by the vent part' -- as had been inserted by amendment within claim 8 (amendment A and amendment D), during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

²⁹ See, Appendix A, Claim 49 ("a corrugated material defining a multiplicity of air passages and a plurality of apertures").

³⁰ See, Appendix A, Claim 49 ("first and second ventilator sections generally symmetrically extending outboard from a substantially longitudinal center line").

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said pocket being at least partially enclosed along a first side disposed closest to the interior region of the roof ventilator by said one of the vent parts as well as said pocket being at least partially enclosed along a second side disposed closest to the exterior region surrounding the roof ventilator by said one of the vent parts.³¹

As shown above and by reciting a narrower limitation than present in the original claim, a reissue claim otherwise subject to the Recapture Rule should be allowed. In the case at issue, the two limitations recited above with respect to the rejection for "a pocket," were not recited in original claim 8 and are present in reissue claim 49. These limitations were neither added nor the subject of amendments during the prosecution of U.S. Patent 5,094,041. Moreover, both of these limitations are materially narrower in aspects unrelated to the rejection of original claim 8. Therefore, the Recapture Rule does not preclude the allowability of reissue claim 49, because claim 49 contains limitations materially narrower in aspects unrelated to the rejection of original claim 8 and Applicants respectfully request reversal of this rejection.

c) a top panel

Claim 49 is rejected under the Recapture Rule for canceling limitations to

a top panel disposed above a pair of vent parts and formed of a pair of planar plies and an intermediate ply, a recessed area cut in the top panel with the recessed area defining a plurality of openings with "each of said plurality of openings having a pair of side walls defined by the intermediate ply, each of said pair of side walls traversing a generally oval shaped path, such that the top panel may be manually folded across a path disposed within said recessed area."³²

³¹ U.S. Patent Application 09/862,905, 5 November 2004 Office Action, page 5 ("Further claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60, (particularly claims 16 and 49), cancel limitations to 'said pocket being at least partially enclosed along a first side disposed closest to the interior region of the roof ventilator by said one of the vent parts' as well as 'said pocket being at least partially enclosed along a second side disposed closest to the exterior region surrounding the roof ventilator by said one of the vent parts' as had been argued as a basis for patentability of claim 8 on pages 2-3 of the July 1, 1991 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

³² U.S. Patent Application 09/862,905, 5 November 2004 Office Action, pages 5-6 ("Claims 49, 51, 52, 54, 56, and 58-60, (particularly claim 49), cancel limitations to — a top panel disposed above a pair of

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As shown above with respect to claim 16, there are two claimed embodiments of the present invention. The first embodiment relates to roof ventilators having apertures or pockets and the second embodiment relates to roof ventilators having a top panel with a recessed area. Claim 49 reads on the second embodiment. Because claim 49 reads on the second embodiment, Applicants submit that requiring claim 49 to also recite the limitations of the first embodiment would be improper.

Additionally and as also shown above, there is no per se rule that reissue claims must have each and every limitation added to every claim of the original patent. The scope of the reissue claims relative to the scope of the original claim is the proper reference for rejection and Applicants respectfully submit that the scope of reissue claim 49 was not addressed by the rejection in the 5 November 2004 Office Action. Therefore, a prima facie case for rejection under the Recapture Rule was not established.

As further shown above, only subject matter present in canceled claims during prosecution of U.S. Patent 5,094,041 is properly subject to the Recapture Rule. The limitation "each of said plurality of openings having a pair of side walls defined by the intermediate ply, each of said pair of side walls traversing a generally oval shaped path, such that the top panel may be manually folded across a path disposed within said recessed area" is not present in a canceled claim of the original patent. Therefore, this limitation is not properly subject to the Recapture Rule.

vent parts and formed of a pair of planar plies and an intermediate ply, a recessed area cut in the top panel with the recessed area defining a plurality of openings with each of said plurality of openings having a pair of side walls defined by the intermediate ply, each of said pair of side walls traversing a generally oval shaped path, such that the top panel may be manually folded across a path disposed within said recessed area -- as had been inserted by amendment within claim 9, as well as argued on pages 4-5 of the

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Because Applicants should not be required to include limitations reading on another claimed embodiment of the invention, because a per se rule was improperly imposed to require inclusion of all limitations added to all original claims, and because a portion of the limitations recited in the rejection are not subject to the Recapture Rule, reissue claim 49 should be allowed and Applicants respectfully request that the rejection be reversed.

3. Claims 17, 21-34, 51-52, 54, 56, and 58-60.

Reissue claims 17 and 21-34 depend from independent claim 16 and reissue claims 51-52, 54, 56, and 58-60 depend from claim 49. None of these dependent claims was separately rejected in the 5 November 2004 Office Action. Therefore, Applicants respectfully submit that these dependent claims should be allowed and respectfully request that the rejection of these claims be reversed as well.

March 4, 1991 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.").

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CONCLUSIONS AND REQUEST FOR RELIEF

In light of these arguments, reversal is respectfully requested for the rejection of the claims for not containing subject matter asserted to be subject to the Recapture Rule. Allowance of all of claims is requested.

Respectfully submitted,



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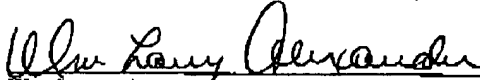
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Wm. Larry Alexander

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APPENDIX A: PENDING CLAIMS

1-15. (Canceled).

16. A roof ventilator, comprising:a top panel; andat least one ventilator section comprising a ventilator first panel and an interconnected ventilator second panel,said at least one ventilator section in parallel abutting contact with the top panel,the top panel and said ventilator first and second panel comprising first and second planar plies and an intermediate ply disposed between the first and second planar plies such that the first and second planar plies and intermediate ply define a multiplicity of air passages extending generally transversely to a roof ventilator longitudinal axis,said at least one ventilator section and the top panel defining a ventilator interior region and a ventilator exterior region surrounding the roof ventilator,the top panel defining a recessed area in which the top panel first planar ply and at least a portion of the top panel intermediate ply have been removed, the recessed area being generally non-linear in cross section and exposing at least a portion of the air passages in the top panel such that the ventilator interior region is in fluid communication with the ventilator exterior region through the recessed area and the air passages.17. The roof ventilator of claim 16, in which a pair of ventilator sections are present.

18. (Canceled)

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19. (Canceled)

20. (Canceled)

21. The roof ventilator of claim 17, each ventilator section further comprising a third panel, the top panel and each said first panel, second panel, and third panel in parallel abutting contact, each said third panel including first and second planar plies and an intermediate ply disposed between the first and second planar plies such that air passages extending generally transversely to the roof ventilator longitudinal axis are defined.

22. The roof ventilator of claim 17, each ventilator section further comprising a third panel, the third panel including first and second planar plies and an intermediate ply disposed between the first and second planar plies such that air passages extending generally transversely to the roof ventilator longitudinal axis are defined, the top panel and each said first, second, and third ventilator panel being defined by generally linear series of perforations extending generally parallel to the ventilator longitudinal axis.

23. The roof ventilator of claim 17, each ventilator section further comprising a third panel, the third panel including first and second planar plies and an intermediate ply disposed between the first and second planar plies such that air passages extending generally transversely to the roof ventilator longitudinal axis are defined, the top panel and each said first, second, and third ventilator panel being defined by slits extending generally parallel to the roof ventilator

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longitudinal axis, each of said slits formed by severing one of the first and second planar plies and the intermediate ply.

24. The roof ventilator of claim 17, each ventilator section further comprising a third panel and a fourth panel, the top panel and each said first, second, third, and fourth panel in parallel abutting contact, each said third and fourth panel comprising first and second planar plies and an intermediate ply disposed between the first and second planar plies such that air passages extending generally transversely to the roof ventilator longitudinal axis are defined, the top panel and each said first, second, third and fourth panel being defined by perforations extending generally parallel to the roof ventilator longitudinal axis.

25. The roof ventilator of claim 17, each ventilator section further comprising a third panel and a fourth panel, each said fourth panel including first and second planar plies and an intermediate ply disposed between the first and second planar plies such that air passages extending generally transversely to the roof ventilator longitudinal axis are defined, the top panel and each said first, second, third and fourth panel being defined by slits extending generally parallel to the roof ventilator longitudinal axis.

26. The roof ventilator of claim 17, each ventilator section further comprising a third panel and a fourth panel, each said third and fourth panel including first and second planar plies and an intermediate ply disposed between the first and second planar plies such that air passages extending generally transversely to the roof ventilator longitudinal axis are defined, the top panel and each said first, second, third and fourth panel being defined by slits extending generally

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parallel to the roof ventilator longitudinal axis, the slits formed by severing one of the first and second planar plies and the intermediate ply.

27. The roof ventilator of claim 17, in which the ventilator section air passages and the top panel air passages extend generally perpendicularly to the roof ventilator longitudinal axis.

28. The roof ventilator of claim 17, in which the portion of the top panel first planar ply adjoining the recessed area defines a generally linear recessed area edge.

29. The roof ventilator of claim 17, in which the recessed area generally coincides with the longitudinal axis of the top panel.

30. The roof ventilator of claim 17, in which the intermediate plies within the top panel recessed area define a generally oval-shaped path.

31. The roof ventilator of claim 17, in which the intermediate plies within the top panel recessed area define a generally nonlinear path.

32. The roof ventilator of claim 17, the recessed area being bounded by edges, the intermediate plies within the top panel recessed area having a minimum height and a maximum height, the minimum height being disposed where all or a maximum portion of the intermediate ply has been removed, the maximum height being adjacent each said edge of the recessed area.

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33. The roof ventilator of claim 32, in which the intermediate ply minimum height generally coincides with a top panel longitudinal axis.

34. A roof in combination with the roof ventilator of claim 17, the roof with a peak and an opening generally coinciding with the roof peak, the roof ventilator attached to the roof such that air from inside the roof can pass from the ventilator interior region, through the roof ventilator, and into the roof ventilator exterior region, via the roof ventilator top panel air passages and each said ventilator section air passages.

35. A method of ventilating a building attic, the method comprising:
placing a vent over a roof opening such that air can pass from the attic, through the ventilator to outside the attic, the vent comprising:

a top panel comprising first and second planar plies and an intermediate ply disposed between the first and second planar plies, the first and second planar plies and second panel intermediate ply defining air passages extending generally transversely to the roof ventilator longitudinal axis, and

a pair of ventilator sections, each said ventilator section configured for parallel abutting contact with a first surface of the top panel and comprising a first panel, each first panel comprising first and second planar plies and an intermediate ply disposed between the first and second planar plies such that air passages extending generally transversely to a roof ventilator longitudinal axis are defined.

the top panel and each said ventilator section defining a ventilator interior region and the top panel defining a ventilator exterior region, the ventilator interior region

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generally bounded by the ventilator sections and one of the top panel planar plies, the

ventilator exterior region bounded by the other of the top panel planar plies,

the top panel defining an area generally arcuate in cross section in which the top
panel first planar ply and at least a portion of the top panel intermediate ply have been
removed, the recessed area exposing at least a portion of the air passages in the top panel
such that the ventilator interior region is in fluid communication with the ventilator
exterior region through the air passages; and
attaching the roof ventilator to the roof.

36. (Withdrawn) The method of claim 35, in which attaching the roof ventilator to the roof
comprises driving fasteners through the ventilator sections into the roof.

37. (Withdrawn) The method of claim 35, in which attaching the roof ventilator to the roof
comprises driving nails through the ventilator sections into the roof.

38. (Withdrawn) The method of claim 35, further comprising covering the roof ventilator
with shingles.

39. (Withdrawn) The method of claim 35, further comprising covering the roof ventilator
with tiles.

40. (Withdrawn) A method of making a roof ventilator, comprising:

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providing a quantity of material comprising first and second planar plies and an intermediate ply, the first and second planar plies and second intermediate ply defining a multiplicity of air passages;

forming a top panel and a pair of ventilator section first panels from the material such that the air passages extend generally transversely to a top panel longitudinal axis; and
defining a recessed area by removing a portion of the top panel, the recessed area being generally arcuate in cross section.

41. (Withdrawn) The method of claim 40, in which a generally linear recessed area is defined.

42. (Withdrawn) The method of claim 41, in which defining the recessed area comprise: removing the first planar ply and a portion of the intermediate ply.

43. (Withdrawn) The method of claim 42, in which the recessed area substantially coincides with a top panel longitudinal axis.

44. (Withdrawn) The method of claim 42, further comprising forming a pair of ventilator section second panels from the material such that the air passages extend generally transversely to ventilator section longitudinal axis.

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45. (Withdrawn) The method of claim 41, in which the top panel and ventilator section first panels are formed by generally linear series of perforations, the ventilator section first panels hinged to the top panel at the perforations.

46. (Withdrawn) The method of claim 41, in which the top panel and ventilator section first panels are formed by slits extending through the second planar ply and the intermediate ply, the ventilator section first panels hinged to the top panel by the intact first planar ply adjacent the slits.

47. (Withdrawn) The method of claim 44, in which the ventilator section second panels are formed by generally linear series of perforations, the ventilator second panels hinged to the ventilator first panels at said perforations.

48. (Withdrawn) The method of claim 44, in which the ventilator section second panels are formed by slits extending through one of said planar plies and the intermediate ply.

49. A ventilator for a roof peak, comprising first and second ventilator sections generally symmetrically extending outboard from a substantially longitudinal center line, each of said first and second ventilator sections comprising interconnected first and second panels, each of said first and second panels comprising a corrugated material defining a multiplicity of air passages and a plurality of apertures, each said first panel and second panel in a contacting stacked relationship, each of said air passages conducting air from inside the roof peak to outside the roof peak, each of said apertures extending generally transversely with respect to the multiplicity of

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air passages, each of said apertures further extending substantially through said first and second panels so as to interrupt at least a portion of said multiplicity of air passages.

50. (Canceled)

51. The ventilator of claim 49, in which said pluralities of first panel apertures are generally aligned with a corresponding one of said second panel apertures.

52. The ventilator of claim 51, in which the first and second panels are longitudinally interconnected.

53. (Canceled)

54. The ventilator of claim 49, in which substantially all of said multiplicity of air passages is interrupted by said plurality of apertures.

55. (Canceled)

56. The ventilator of claim 54, in which the corrugated sheet material comprises plastic.

57. (Canceled)

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58. The ventilator of claim 56, in which each said first and second panels are interconnected by slit-scoring.

59. The ventilator of claim 56, in which each said first and second panels are interconnected by nick-scoring.

60. A roof comprising the ventilator of claim 49 operably present at a peak of said roof.

61. (Withdrawn) A process of forming a ventilator for a peak of a roof, comprising forming a pair of ventilator sections extending generally symmetrically from a ventilator centerline, each of said pair of ventilator sections comprising a multiplicity of air passages conveying air from inside the roof peak to outside the roof peak, each of said pair of ventilator sections further comprising a plurality of apertures, a portion of said multiplicity of air passages interrupted by said plurality of apertures, each of said apertures extending substantially transversely with respect to said multiplicity of air passages.

62. (Withdrawn) The process of claim 61, in which each of said pair of ventilator sections comprises a first ventilator section layer and a second ventilator section layer and in which said first and second ventilator section layers are formed so that each of said plurality of apertures formed in the first ventilator section layer aligns with one of said plurality of vent apertures formed in the second ventilator section layer.

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63. (Withdrawn) The process of claim 61, in which each of said pair of ventilator sections comprises a plurality of longitudinally interconnected ventilator section layers and in which forming said pair of ventilator sections comprises disposing said ventilator section layers in a stacked relationship.

64. (Withdrawn) The process of claim 63, in which each of said pair of ventilator sections is formed from a blank of corrugated material.

65. (Withdrawn) The process of claim 63, in which each of said pair of ventilator sections is formed from a blank of double-faced corrugated plastic material.

66. (Withdrawn) The process of claim 61, in which each of said pair of ventilator sections is formed from a blank of corrugated material.

67. (Withdrawn) The process of claim 61, in which each of said pair of ventilator sections is formed from a blank, said blank comprising a corrugated ply disposed between a pair of generally planar plies.

68. (Withdrawn) The process of claim 61, in which each of said pair of ventilator sections is formed from a blank of double-faced corrugated plastic material.

69. (Withdrawn) The process of claim 61, in which said multiplicity of air passages extend generally perpendicularly to said ventilator centerline.

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70. (Withdrawn) The process of claim 69, in which said multiplicity of air passages are generally parallel.

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APPENDIX B: EVIDENCE

None

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APPENDIX C: RELATED PROCEEDINGS

None